



BEST AVAILABLE COPY

UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

*J.L.R.*

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/350,297	07/09/99	SHIBATA	99143

QM12/1114

WILLIAM H MESEROLE  
DENNISON MESEROLE SCHEINER & SCHULTZ  
1745 JEFFERSON DAVIS HIGHWAY SUITE 612  
ARLINGTON VA 22202

EXAMINER

RACHUBA, M

ART UNIT

PAPER NUMBER

3724

#7

DATE MAILED:

11/14/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/350,297

Applicant(s)

SHIBATA ET AL.

Examiner

M Rachuba

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 July 1999 is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☒ All b) ☐ Some \* c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☒ received.
2. ☐ received in Application No. (Series Code / Serial Number) \_\_\_\_\_.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3,4.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of claims 1-3 and 12-16 in Paper No. 6 is acknowledged. Given the prior art now cited, the examiner has withdrawn the species requirement. Claims 1-16 are treated on their merits, in the action set forth below.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are replete with functional language not fully supported by structural limitations. For example, Claim 1, it is not clear if there is a battery, as it has not been positively claimed. Claim 2, "handle operable by" is not clear, because there is no structure to support this function. Claim 3, what structure connects the switch to the motor?

Claim 5, "the diametrical direction of the table" lacks antecedent basis.

Claim 10 depends from itself.

Claim 13, how can the handle, battery and battery mounting device all be mounted in the same plane as the blade? What plane is being claimed?

Applicant should note that the limitations such as "a battery mounting device", "a saw unit" and "a base for supporting" are not in compliance with the Supplemental Guidelines published in the Official Gazette on July 25, 2000. Such limitations cannot

Art Unit: 3724

be used to invoke 35 USC 112, 6<sup>th</sup> paragraph, and have therefore been given their broadest reasonable interpretation, without considering equivalence.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 4-11, 13 and 16 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Felisatti, Catalog, 1996 and Price List, 1/1996, showing battery operated saw T777B. T777B is a battery operated table saw, having a main rotary table flanked by two opposing auxiliary tables; a saw unit having a saw blade; a handle, a battery driven motor, and a battery mounting device on the table saw. The battery mounting device is mounted on the base, mounted on both tables, the battery mounted so as to serve as a counterbalance where ever the saw is positioned; the batter mounting device mounted in a position adjacent the pivotal axis of the saw unit; the battery mounting device is considered to be mounted on the blade case via the base of the device, which is also mounted to the blade case; the battery mounting device being mounted across the base, and therefore positioned on one lateral side of the blade case opposite the motor; as can be best understood, the handle, battery mounting device, and motor are positioned substantially within the same plane as the blade; the battery is a 24 Volt Ni-Cd rechargeable.

Art Unit: 3724

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 2, 3 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Felisatti in view of Ando. Felisatti discloses a table saw with the battery mounted on the base. Ando teaches a saw, to be operated by the operator grasping the handle and moving the saw, where the rechargeable battery is mounted in the handle, adjacent the motor switch. It would have been obvious to one of ordinary skill at the time of the invention to have provided Felisatti with the battery mounted to the handle, to improve operator control of the tool, as taught by Ando, column 2, lines 3-27.

8. Claims 12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Felisatti. Felisatti does not clearly disclose that the battery mounting device has

Art Unit: 3724

openings. The examiner takes Official notice that one of ordinary skill would have found it obvious to provide openings in any casing used with a tool, for debris and heat removal. Further, Felisatti does not clearly disclose that the connection between the motor and blade is a belt. The examiner takes Official notice that one of ordinary skill would know of motors that use belts to drive tools, and would have found it obvious to have provided the motor of Felisatti with such a connection.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Other battery driven tools are cited.

10. Any inquiry concerning the content of this communication or earlier communications from the examiner should be directed to M. Rachuba whose telephone number is (703) 308-1361. The examiner can normally be reached on Monday through Friday from 8:30 AM to 3:00 PM. Any inquiries concerning other than the content of this and previous communications, such as missing references or filed papers not acknowledged, should be directed to the Customer Service Representative, Tech Center 3700, (703) 306-5648.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada, can be reached on (703) 308-2187. The fax phone number for this Group is (703) 305-3579.

In order to reduce pendency and avoid potential delays, Group 3720 is encouraging FAXing of responses to Office actions directly into the Group at (703) 305-3579. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a PTO

Art Unit: 3724

deposit account. Please identify Examiner Rachuba of Art Unit 3724 at the top of your cover sheet.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1148.

M. RACHUBA  
PRIMARY PATENT EXAMINER  
ART UNIT 3724



mtr  
October 11, 2000